

REMARKS/ARGUMENTS

Claims 1-69 remain in this application.

The Examiner has indicated that the listing of references in the specification is not a proper information disclosure statement. Applicants submit that an Information Disclosure Statement was mailed on December 17, 2003 (postcard received December 19, 2003), and a Supplemental Information Disclosure Statement was mailed on May 5, 2004 (postcard received May 7, 2004).

The Examiner has rejected claims 24-33, 36, 39, 40, 66 and 67 under 35 U.S.C. 102(e) as being anticipated by Swisher et al (U.S. Patent 6,477,926). Applicants submit that a declaration is filed herewith under 37 CFR 1.132 to show that the application and the reference were, at the time the invention was made, owned by and subject to an obligation of assignment to the same entity, i.e., PPG Industries, Incorporated. Applicants further submit that the affidavit overcomes the rejection under 35 U.S.C. 102(e).

The Examiner has also rejected claims 1-10, 13, 16-18, 21, 23, 41, 44, 45, 47-55, 58-65, 68 and 69 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Swisher et al (U.S. Patent 6,477,926). As previously indicated, an affidavit is filed herewith under 37 CFR 1.132 to show that the application and the reference were, at the time the invention was made, owned by and subject to an obligation of assignment to the same entity, i.e., PPG Industries, Incorporated. In regards to the rejection under 35 U.S.C. 103(a), Applicants submit that Swisher et al reference discloses a polishing pad comprised of particulate polymer and crosslinked organic polymer binder having a percent pore volume of from 2 percent by volume to 50 percent by volume. However, the Swisher et al reference does not disclose nor suggest a three layer assembly wherein the top layer absorbs at least two percent by weight of polishing slurry based on the total weight of the top layer, nor does the Swisher et al reference disclose that the top layer has a percent volume compressibility greater than the middle layer, nor does the Swisher et al reference disclose that the sublayer is softer than the top layer. The Swisher et al reference does not even suggest volume compressibility values and thus, does not provide a method of measuring such values. Further, the Swisher et al reference does not disclose Shore A or D hardness values relative to the top layer and sublayer; the Swisher et al reference discloses that the backing sheet can be rigid or flexible.

It is now well established by the Federal Circuit that cited prior art must provide one of ordinary skill in the art with the motivation to use the disclosure of a reference in a manner

that renders the claims obvious; namely, there must be some teaching suggestion or incentive in the prior art disclosure that supports the rejection. This requirement stands as the critical safeguard against hindsight analysis and rote application of the legal test for obviousness. See, in particular, *In re Rouffet*, 47 USPQ 2d 1453, 1458 (Fed. Cir. 1998). Further, see, *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), wherein the Court found that “The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art ... Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.”

Further, the Examiner has rejected claims 11, 12, 14, 15, 19, 20, 22, 34, 45, 37, 38, 42, 43, 46, 56, 57, 59 and 60 under 35 U.S.C. 103(a) as being unpatentable over Swisher et al (U.S. Patent 6,477,926). The Examiner indicates that it would have been obvious to select the claimed thickness or percent volume compressibility. Applicants submit that the Swisher et al reference does not suggest a thickness nor percent volume compressibility. Further, without hindsight analysis, there would be no motivation for one skilled in the art to modify the disclosure in Swisher et al to obtain the claimed invention. See, *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989), wherein the Court found that “Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, ‘[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.’” In *Ex parte Haymond*, 41 USPQ 2d 1217 (Bd. of Appeals 1996) the Court found that it is impermissible to use the claimed invention as an instruction manual or “template” in order to render the claimed invention obvious.

Thus, Applicants submit that claims 11, 12, 14, 15, 19, 20, 22, 34, 45, 37, 38, 42, 43, 46, 56, 57, 59 and 60 should not be rejected under 35 U.S.C. 103(a).

Based on the reasoning set forth herein, Applicants submit that the claims 1-69 are in condition for allowance and therefore respectfully request reconsideration of the claims.

Very truly yours,

A handwritten signature in cursive script that reads "Carol A. Marmo".

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